

## REMARKS

Claims 1-21 are currently pending in the above-identified patent application.

In the above-identified Office Action, made final, the Examiner stated that applicant's arguments with respect to claims 1, 8, and 15 have been considered but are moot in view of the new ground(s) of rejection. The Examiner continued that applicants note that Thurston teaches: "The device independent firmware update utility initiates the update of firmware on a plurality of different types of hardware devices and requests device specific functions from device dependent plug-in modules. A different device dependent plug-in module may be provided for each type of hardware device. Thus the firmware update application separates device independent firmware update functions from device dependent update functions." The Examiner continued that this quotation only states that the device dependent portion **may** be provided, not that it necessarily be included, and that this indicates that there are times that a device dependent is not included, and that therefore, the limitation still may be met.

Applicants respectfully disagree with the Examiner interpretation of the word "may" in the quoted selection. Paragraph [0026] of Thurston et al. states that: "Described implementations divide firmware updated operations into device-independent and device dependent steps. Implementations provide a device independent application coupled to a plurality of device dependent applications for updating firmware in hardware devices coupled to a computer system. The device independent application is an application that does not perform operations that are dependent on characteristics of the hardware devices coupled to the computer system." (Emphasis added by applicants.). Paragraph [0069] of Thurston et al. states that: "The implementations provide a firmware update application for updating firmware on different types of hardware devices. The firmware update application comprises a device independent firmware update utility and a plurality of device dependent plug-in modules. The device independent firmware update utility initiates the update of firmware on a plurality of different types of hardware devices and requests device specific functions from device dependent plug-in modules. A different device dependent plug-in module may be provided for each

type of hardware device. Thus the firmware update application separates device independent firmware update functions from device dependent update functions.” (Emphasis added by applicants.).

Applicants wish to direct the Examiner’s attention to the previous sentence to: “A different device dependent plug-in module may be provided for each type of hardware device.” which requires that: “The device independent firmware update utility initiates the update of firmware on a plurality of different types of hardware devices and **requests device specific functions from device dependent plug-in modules.**” Thus, device specific functions from device dependent plug-in modules are positively requested by the update utility. The sentence in question simply states that a different device dependent plug-in module may be provided for each type of hardware device. That is, each plug-in module might be different from the other modules. That the device dependent portion **may** be provided, as interpreted by the Examiner, is not supported by the previous sentence where the device requests device specific functions from device dependent plug-in modules. Thus, applicants believe: (1) that this language does not indicate that there are times that a device dependent plug-in module is not included; and (2) that the limitations in claims 1, 8 and 15 are not met.

The Examiner then repeated the rejection to Claims 1, 2, 4-6, 8, 9, 11-13, 15, 16, and 18-20 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2003/0217358 to Thurston et al., set forth in the Office Action dated February 27, 2007, continuing that Thurston et al. teaches, by silence that no translation occurs at the time of execution.

Applicants respectfully disagree with the Examiner concerning the rejection of claims 1, 2, 4-6, 8, 9, 11-13, 15, 16, and 18-20 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2003/0217358 to Thurston et al., for the reasons to be set forth hereinbelow.

Claims 1, 2, 4-6, 8, 9, 11-13, 15, 16, and 18-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2003/0217358 to Thurston et al. in further view of Ex parte Wu, In re Larson, In re Kuhle, and U.S. Patent Application Publication 2001/0014093 to Yoda et al., since

the Examiner stated that with regard to claims 1, 8, and 15, Thurston teaches packaging a communication sequence into a script by a method comprising (paragraph 29), providing said communication sequence that is a specific set of actions and action data (paragraphs 34-39); for each of said actions, creating an action header comprising an action code and one or more component specific commands (paragraphs 40-43), and creating an action payload comprising zero or more of said action data; transmitting said script to said controller (paragraphs 34-39); and communicating to said component of said system by running said script by said controller by a method comprising: providing said script to said controller (paragraphs 35-39); and for each of said action headers, executing a command corresponding to said action code (paragraphs 35-39 and 19-52), transmitting said one or more component specific commands to said component (paragraphs 35-39 and 19-52) and that the commands may be transmitted verbatim, without adding a device dependent portion (paragraph 69), and transmitting said zero or more of said action data from said action payload verbatim to said component (paragraphs 35-39 and 19-52). The Examiner then stated that Thurston et al. teaches, by silence that no translation is occurring at the time of execution, and that Thurston does not teach that the component specific commands and action data from said action payload are always transmitted verbatim, but rather that they may be transmitted with or without device dependent portion, and that this completed portion (with or without device dependent portion) is transmitted without further change. However, the Examiner concluded that the omission of an element and its function is obvious if the function of the element is not desired. Ex parte Wu, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989). See also In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) (Omission of additional framework and axle which served to increase the cargo carrying capacity of prior art mobile fluid carrying unit would have been obvious if this feature was not desired); and In re Kuhle, 526 F.2d 533, 188 USPQ 7 (CCPA 1975) (deleting a prior art switch member and thereby eliminating its function was an obvious expedient).

The Examiner stated further that Yoda teaches that it was well known in the art to transmit packets unchanged along a path (paragraph 50), and that it would

have been obvious to one of ordinary skill in the art to eliminate the possibility of an alteration of the firmware package in *Thurston et al.* in order to eliminate the function of device dependent alterations and the associated costs and complexity associated with the extra functions.

Applicants respectfully disagree with the Examiner concerning the rejection of claims 1, 2, 4-6, 8, 9, 11-13, 15, 16, and 18-20 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2003/0217358 to *Thurston et al.* in further view of *Ex parte Wu*, *In re Larson*, *In re Kuhle*, and U.S. Patent Application Publication 2001/0014093 to *Yoda et al.* since, as stated hereinabove, *Thurston et al.* does not indicate that there are times that a device dependent plug-in module is not included. Thus, applicants respectfully believe that the Examiner's position that *Thurston et al.* teaches by silence that no translation is occurring at the time of execution, that the component specific commands and action data from said action payload may be transmitted with or without device dependent portion, and that this completed portion (with or without device dependent portion) is transmitted without further change, is incorrect.

Further, the Examiner's conclusion that the omission of an element and its function is obvious **if the function of the element is not desired** under *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. and Inter. 1989), *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) (Omission of additional framework and axle which served to increase the cargo carrying capacity of prior art mobile fluid carrying unit would have been obvious if this feature was not desired), and *In re Kuhle*, 526 F.2d 533, 188 USPQ 7 (CCPA 1975) (deleting a prior art switch member and thereby eliminating its function was an obvious expedient), is likewise incorrect since applicants' claimed invention does not simply eliminate the function of the device dependent applications required by *Thurston et al.* to install device independent firmware on hardware devices; rather, the present claimed invention claims and teaches a controller with little or no logic for handling device-specific interactions for communicating with a device using a script file. The function of the element is still desired, but a different process is used to achieve it.

The Examiner stated further that Yoda et al. teaches that it was well known in the art to transmit packets unchanged along a path (paragraph 50), and that it would have been obvious to one of ordinary skill in the art to eliminate the possibility of an alteration of the firmware package in Thurston et al. in order to eliminate the function of device dependent alterations and the associated costs and complexity associated with the extra functions. Applicants fail to understand how the Examiner has applied Yoda et al. in the above rejection, since paragraph [0050] states in part: "... the amount of data included in packets is **generally** constant en route, regardless of whether the data have been used to form separate packets or have been used to assemble a single packet. ... ." (Emphasis added by applicants.). The word "generally" means that there are occasions when the amount of data might change along route; it does not mean "always." The Abstract of Yoda et al. states: "A change in the size of the data in a packet in accordance with the time of the first connection, and a change in the size of the data in a packet in accordance with the time of the second connection are calculated ... ." Thus, the amount of data may change in accordance with the teachings of Yoda et al., and applicants fail to understand how it would be obvious "to eliminate the possibility of an alteration of the firmware package in Thurston et al. in order to eliminate the function of device dependent alterations and the associated costs and complexity associated with the extra functions.", as suggested by the Examiner.

Claims 3, 10, and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2003/0217358 to Thurston et al. in further view of U.S. Patent 6,789,157 to Lilja et al. for the reasons set forth in the Office Action dated February 27, 2007.

Applicants respectfully disagree with the Examiner concerning the rejection of claims 3, 10, and 17 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2003/0217358 to Thurston et al. in further view of U.S. Patent 6,789,157 to Lilja et al., for the reasons to be set forth hereinbelow.

Claims 7, 14, and 21 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2003/0217358 to Thurston et al. and further in view of U.S. Patent Application Publication 2002/0166027 to

Shirasawa et al., for the reasons set forth in the Office Action dated February 27, 2007. Applicants respectfully disagree with the Examiner concerning the rejection of claims 7, 14, and 21 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2003/0217358 to Thurston et al. and further in view of U.S. Patent Application Publication 2002/0166027 to Shirasawa et al., for the reasons to be set forth hereinbelow.

Reexamination and reconsideration are requested.

Turning now to Thurston et al., where in Paragraph [0026] it is stated that: "Described implementations divide firmware updated operations into device-independent and device dependent steps. Implementations provide a device independent application coupled to a plurality of device dependent applications for updating firmware in hardware devices coupled to a computer system. The device independent application is an application that does not perform operations that are dependent on characteristics of the hardware devices coupled to the computer system. The device dependent applications are applications that may contain operations that are dependent on characteristics of the hardware devices coupled to the computer system." In paragraph [0038] of Thurston et al. it is set forth that: "The device dependent plug-in modules **306** are device dependent applications that may contain operations dependent on the characteristics of the hardware device **310**, **311**." In Paragraph [0069], Thurston et al. continues that: "The implementations provide a firmware update application for updating firmware on different types of hardware devices. The firmware update application comprises a device independent firmware update utility and a plurality of device dependent plug-in modules. The device independent firmware update utility initiates the update of firmware on a plurality of different types of hardware devices and requests device specific functions from device dependent plug-in modules. A different device dependent plug-in module may be provided for each type of hardware device. Thus the firmware update application separates device independent firmware update functions from device dependent update functions." (Emphasis added by applicants.). Paragraphs [0038] and [0039] state that: "The device independent firmware updated utility **302** is a device independent application that does not

perform operations that are dependent on characteristics of the hardware device **310, 311**. The device dependent plug-in modules **306** are device dependent applications that may contain operations dependent on characteristics of the hardware device **310, 311**. An entity, such as a software vendor, that creates the firmware updated application **200**, may provide a firmware package construction tool **314**, where the firmware package construction tool **314** may be used by different vendors to construct the firmware package **108a**. The firmware package construction tool **314** ensures that the data structure comprising the firmware package **108a** are compatible with the firmware update application **200**." And in Paragraph [0046] Thurston et al. states that: "The device independent firmware update utility **302** extracts the list of properties package **402** from the firmware update package **108a** and forwards the firmware update package **108a** to the device dependent plug-in module **306**. In alternative implementations, the device independent firmware update utility **302** may extract the <name, value> pairs from the list of properties package **402** and forward the name value pairs to the device dependent plug-in module **306**. The device dependent plug-in module **306** uses the <name, value> pairs to apply the dynamic constraints for the firmware update encapsulated in to the <name, value> pairs."

The above-quoted paragraphs from Thurston et al., along with FIG. 3 thereof clearly show the requirement of a device dependent plug-in module, **306** for installing firmware updates onto hardware devices.

By contrast, subject independent claims 1, 8 and 15, as amended, in part recite the following: "1. ... communicating to said component of said system by running said script by said controller by a method comprising: ... for each of said action headers, executing a command corresponding to said action code, transmitting said one or more component specific commands verbatim to said component, and transmitting said zero or more of said action data from said action payload verbatim to said component." (Emphasis added by applicants.).

Parallel recitations may be found in subject claims 8 and 15. Thus, the independent claims of the present invention require that component specific instructions are provided to a system controller to update a chosen component. As

an example, the controller then transmits the one or more component specific commands verbatim, and without component specific changes to the action code, to the component. Further, the present, claimed system controller does not request component specific commands or functions from device dependent plug-in modules which translate the directions from the controller into commands the individual devices can process.

Therefore, applicants respectfully believe that Thurston et al. teaches away from the present claimed invention, and cannot anticipate the present claimed invention.

Dependent claims 2, 4-6, 9, 11-13, 16, and 18-20 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2003/0217358 to Thurston et al. Since applicants believe that independent claims 1, 8 and 15, as amended, are patentably distinguishable over Thurston et al. for the reasons set forth hereinabove, applicants believe that no further response is required with respect to the above-identified dependent claims.

Turning now to the rejection of dependent claims 3, 7, 10, 14, 17, and 21 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2003/0217358 to Thurston et al. in view of other references, since applicants believe that Thurston et al. teaches away from the present claimed invention and, in particular independent claims 1, 8, and 15, as amended, applicants believe that the Examiner has not made a proper *prima facie* case for obviousness as is required under 35 U.S.C. 103(a), because there would be no motivation to combine Thurston et al. with these references. See Section X.D. 1. and X.D.2. of the Manual Of Patent Examining Procedure.

In the subject Office Action, the Examiner rejected applicants' argument that Thurston teaches away from the claimed invention. In support of this argument, the Examiner cited: "A *prima facie* case of obviousness can be rebutted if the applicant...can show that the art in any material respect taught away' from the claimed invention... A reference may be said to teach away when a person of ordinary skill, upon reading the reference...would be led in a direction divergent from the path that was taken by the applicant." *In re Haruna*, 249 F.3d 1327,



58USPQ2d 1517 (Fed. Cir. 2001). A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). However, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed..." *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). The Examiner concluded that the alternative presented by Thurston et al. does not teach away from the claimed invention, but is rather an alternative in which additional portions may or may not be added. As stated hereinabove, Thurston et al. does not provide an alternative; rather, Thurston et al. is quite clear that the package is changed, and applicants respectfully believe that Thurston et al. teaches away from the present claimed invention.

In view of the discussion presented hereinabove, applicants believe that subject claims 1-21, as amended, are in condition for allowance or appeal, the former action by the Examiner at an early date being earnestly solicited.

Reexamination and reconsideration are respectfully requested.

Respectfully submitted,

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Date: August 13, 2007